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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,729	03/18/2004	Dana Marie Walker	100041-41193	6036

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EXAMINER

CARTER, MONICA SMITH

ART UNIT PAPER NUMBER

3722

DATE MAILED: 08/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/803,729

Applicant(s)

WALKER ET AL.

Examiner

Monica S. Carter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Request for Continued Examination***

1. The request filed on July 29, 2005 for a Request for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 10/803,729 is acceptable and an RCE has been established. An action on the RCE follows.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-4, 7-14, 16-22, 25-32 and 34-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Attachment A ("A") or Attachment B ("B") in view of Lang ('426).

A or B discloses a front cover having a plurality of openings located generally adjacent to a binding edge of the front cover; a back cover having a plurality of openings located generally adjacent to a binding edge of the back cover; a plurality of sheets of paper each having a plurality of openings located generally adjacent to a binding edge thereof; a twin-wire binding having a plurality of turns, wherein each of the plurality of openings of the front cover, the back cover, and the plurality of sheets of paper receives a turn of the binding therethrough to bind said front cover, the back cover, and the plurality of sheets of paper together; and a binding guard having a first edge and a

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second edge, wherein the first edge is fixedly attached to the front cover generally adjacent to the binding edge of the front cover and the second edge is fixedly attached to the back cover generally adjacent to the binding edge of the back cover such that the guard generally covers an exposed portion of the binding.

A or B discloses the claimed invention except for explicitly disclosing the binding being generally a helical binding coil.

Lang discloses a spiral-bound or helical-coil bound scuba checklist (see figures 1 and 2). Lang discloses that "Spiral binding is a very popular, well-known, conventional binding system, commonly used in situations in which the binding is meant to be permanent, without the need to add additional pages at a later date." (see [0036]). Lang teaches that helical-coil binding is an equivalent structure known in the art. Therefore, because these two binding methods were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute helical-coil binding for twin-wire binding.

Regarding claim 2, A or B, as modified by Lang, disclose the coil bound notebook wherein the front cover, the back cover, and the plurality of sheets of paper are each generally rectangular in front view and are generally aligned.

Regarding claim 3, A or B, as modified by Lang, disclose the coil bound notebook wherein each of the front cover, back cover, and plurality of sheets of paper include a free edge oriented generally parallel to the associated binding edge and located on an opposite side thereof.

Regarding claims 4 and 22, A or B, as modified by Lang, discloses the claimed invention except for the sheets of paper being cellulose-based material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any required material for the sheet of paper, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice. *In re Leshin*, 125 USPQ 416.

Regarding claim 7, A or B, as modified by Lang, disclose the coil bound notebook wherein the plurality of openings on the front cover, the back cover, and the plurality of sheets of paper each include at least ten openings arranged generally linearly to form a line that is generally parallel to, and extends along, the associated binding edge.

Regarding claim 8, A or B, as modified by Lang, disclose the coil bound notebook wherein each opening of one of the front cover, back cover, or plurality of sheets of paper are spaced from one another by a uniform distance.

Regarding claim 9, A or B, as modified by Lang, disclose the coil bound notebook wherein the wire guard is attached to front cover and the back cover by stitches extending through the wire guard and at least partially through the associated one of the front or back cover.

Regarding claim 10, A or B, as modified by Lang, disclose the coil bound notebook wherein the notebook is moveable to a closed position such that the front cover and the back cover are generally parallel and facing each other and wherein the plurality of sheets of paper are located therebetween.

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Regarding claim 11, A or B, as modified by Lang, disclose the coil bound notebook wherein the wire guard is pulled tight against the helical binding coil when the notebook is in the closed position.

Regarding claim 12, A or B, as modified by Lang, disclose the coil bound notebook of claim 1 wherein the front cover and the back cover each have at least one of a thickness or stiffness that is greater than a sheet of said plurality of sheets of paper.

Regarding claim 13, A or B, as modified by Lang, disclose the coil bound notebook wherein the wire guard extends generally an entire length of the binding edge of the front cover and the back cover.

Regarding claim 14, A or B, as modified by Lang, disclose the coil bound notebook wherein the wire guard is generally flexible.

Regarding claim 16, A or B, as modified by Lang, disclose the coil bound notebook wherein the binding coil is a generally continuous single element formed in a helical shape.

Regarding claim 17, A or B, as modified by Lang, disclose the coil bound notebook wherein the first edge and the second edge of the wire guard are generally not visible when the notebook is in a closed position such that the front cover and back cover are generally parallel and facing each other with the plurality of sheets located between to provide a hidden seam.

Regarding claims 18-21, 25-32 and 34-38; the method for making a notebook is inherently disclosed in the above rejections. Regarding the back cover being positioned between the plurality of sheets of paper and the front cover and the coil guard being

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positioned between the front cover and the back cover, the back cover of either A or B would be positioned between the plurality of sheets of paper and the front cover when the front cover is rotated at an angle counterclockwise to the back cover and rests on the back surface of the back cover and the sheets of paper rest on the top surface of the back cover with the coil guard being positioned between the front and back covers.

4. Claims 5, 6, 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over A or B in view of Lang and further in view of Dorsey ('624).

A or B, as modified by Lang, discloses the claimed invention except for the sheets of paper including a tear guide line extending generally parallel to the binding edge and holes being located generally adjacent to the binding edge and located generally inwardly of the tear guide line.

Dorsey discloses a notebook having perforations (12a, 12b, 12c) in the front cover (4), rear cover (6) and individual pages (9) spaced from the binding means (10), wherein the pages have holes located generally adjacent the binding edge inwardly of the perforations (see figure 2). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the sheets of paper of A or B to include perforations, as taught by Dorsey, to enable the sheets of paper to be torn away from the notebook and discarded or used separately from the notebook.

5. Claims 15 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over A or B in view of Lang and further in view of Su ('771).

A or B, as modified by Lang, discloses the claimed invention except for the notebook having a loop shaped to receive a writing instrument.

Su discloses a loose leaf-binding device having a loop (35) attached to the back cover (30) of the notebook for receiving a writing instrument (40a). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the notebook of A or B to include a loop for receiving a writing instrument, as taught by Su, to include a writing instrument integral with the notebook.

### ***Response to Arguments***

6. Applicant's arguments filed July 29, 2005 have been fully considered but they are not persuasive.

Applicant argues that neither A nor B teach the use of a helical binding coil to bind a pair of covers and a plurality of sheets together. The examiner continues to assert that even though A and B do not explicitly disclose the use of a helical binding coil, Lang discloses that it is known to provide a notebook having conventional helical coils for its binding mechanism. Since the intent of the present invention is to permanently bind the cover and the pages together and the purpose of the helical coil of Lang is to be "used in situations in which the binding is meant to be permanent, without the need to add additional pages at a later date" ([0036]), it would have been obvious to substitute the helical coil binding of Lang for the twin-wire binding of A or B.

Because both A or B and Lang teach using binding mechanisms that permanently bind front and back covers and sheets of paper together, it would have



been prima facie obvious to substitute one binding mechanism for the other. Express suggestion to substitute one equivalent for another need not be present to render such substitution obvious. Nevertheless, a reason for making the substitution is provided by Lang, who states: "Spiral binding is a very popular, well-known, conventional binding system, commonly used in situations in which the binding is meant to be permanent, without the need to add additional pages at a later date." Furthermore, both A or B and Lang are concerned with the identical field of endeavor -- permanently binding covers and sheets of paper together.

Applicant argues that Lang fails to explicitly suggest the use of a spiral binding in a notebook with a binder guard. It is noted that Lang is used to solely disclose the use of an art-recognized binding mechanism (helical-coil binding) in a notebook and has not been relied upon for disclosing any of the other claimed limitations.

For the reasons as set forth above, the rejections are maintained.

### ***Conclusion***


7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica S. Carter whose telephone number is (571) 272-4475. The examiner can normally be reached on Monday-Thursday (6:00 AM - 3:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on (571) 272-4502. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

August 25, 2005

  
**MONICA S. CARTER**  
**PRIMARY EXAMINER**